

REMARKS

Claims 30-38 are pending. Claims 1-25, 28 and 29 have been cancelled without prejudice or disclaimer. As the above-amendments are presented in the format described in the proposed revision to 37 CFR § 1.121, no clean copy of the amended claims is being provided. Applicants thank the Examiner for withdrawing the previous rejections under 35 USC § 102.

I. 35 USC § 112

Claims 1 and 28 stand rejected under 35 USC § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim that which is considered the invention. Applicants respectfully present that this rejection is now moot, as claims 1 and 28 have been cancelled.

II. 35 USC § 103

A. Claims 1-25, 28 and 29

Claims 1-25, 28 and 29 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over JP 4-1268571, in view of one or more of Gaeta et al. (U.S. Patent No. 5,624,471), Argobast et al. (U.S. Patent No. 5,011,709), GB 1121082, GB 2324982, Siry et al. (U.S. Patent No. 4,501,635), and Barker et al. (U.S. Patent No. 4,233,343). However, as each of these claims has been cancelled, Applicants respectfully present that this rejection is now moot.

B. Claims 35-37

Claims 35-37 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over JP '571 in view of Gaeta et al. The Office Action asserts that the combination of references teaches each feature of the rejected claims, except for forming an overall design scheme in individual portions. However, the Office Action states that such a feature would be apparent to one of ordinary skill in the art, as being "common knowledge and common sense".

Although the Office Action asserts that (i) dividing a design into a plurality of segments, each segment corresponding to the size and shape of various surface elements and (ii) adding the

separate segments each to an upper surface of one surface element to reproduce the design across the surface elements, no reference teaching such a process has been cited.

While Applicants agree that the general concept of dividing a large image into a plurality of smaller pieces, such that the large image can be reproduced when the smaller pieces are correctly assembled, e.g., a jigsaw puzzle, is generally known, the Office Action uses impermissible hindsight in rejecting these claims. (However, while in producing a jigsaw puzzle, the image is produced across a unitary element, which is then divided into a plurality of “pieces”, according to the present claims, the image is divided before being transmitted onto the surface elements.)

Assuming arguendo, even if one of ordinary skill in the art wishes to form an image across a number of surface elements, when the image is larger than the individual surface elements, such that it may be obvious to divide “the design into a plurality of segments, each segment having a surface area corresponding to the surface area of one of the surface elements” and thereafter, provide “the decorative upper surfaces with decor layers, the decor layers each comprising one segment of the design, such that when the surface elements are installed, the design is reproduced across the plurality of surface elements”, the Office Action does not identify a motivation to form such an image nor any method or series of steps to impart a segment of the image of a decorate surface element having a base layer and a decorative upper surface, such that when the surface elements are installed, the design is reproduced across the plurality of surface elements.

Reconsideration and withdrawal of the rejection is thus requested.

C. Claims 30-34

Claims 30-34, inter alia, stand rejected under 35 USC § 103(a) as being unpatentable over JP ‘571 in view of Gaeta et al. alone, or in view of Argobast et al. or GB 1121082, in further view of GB 2324982.

The Office Action cites GB ‘982 for its teaching of a “computer-aided screen printing to apply the UV curable ink to the substrate” (Page 9, lines 4-8). However, Applicants respectfully present that the “computer-aided” process of the reference is quite different from the presently recited process. In particular, independent claim 30 recites providing a decorative upper surface of a surface element with a decor layer, wherein the decor layer includes a pattern derived from the

digitized design. Thus, according to the present claims, a computer is used to generate the pattern on the decor layer.

In contrast, the “computer-aided” process of GB ‘982 performs a different step. In fact, a digitized image is used to produce a film positive image on, for example, a screen of silk. Only after the screen is produced, is the screen used to transfer ink to a substrate, via a conventional screen printing method. Thus, no computer is used to transfer an image to the substrate.

Applicants also respectfully take issue with the Examiner’s minimization of an element recited by the claims. In order to establish a prima facie case of obviousness, the cited references “must teach or suggest all claim limitations”. MPEP § 2142 and 2143, citing In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Thus, stating

“It simply makes no difference if the design downloaded into the computer of Pieters to image a wood grain or (other pattern) is transmitted by mail, Internet, FAX, etc [*sic*] because the outcome would be the same and the means of transmitting the design would have been obvious and conventional” (Page 9, lines 13-17)

is not sufficient to eliminate a feature recited by the claims. Additionally, it is irrelevant if “the outcome would be the same”, as claims 30-34 are directed to a process, not a product nor a product-by-process, because it is the particular steps recited by the claims, not the resulting product, which is to be examined in process claims, such as these.

In any event, despite the comment that “It simply makes no difference if the design downloaded into the computer ...”, Applicants respectfully present that it does make a difference that the image is a digitized design at a first location and transmitted to a second location remote from the first location, where a pattern is derived from the digitized design. In one embodiment, the invention described by claims 30-34 allows a user to select a particular motif or design from a database of digitized designs to be reproduced on decorative surfaces through a minimum of steps by generating a pattern derived from the selected design. In another embodiment, a pattern may be digitized from a natural phenomena, e.g., a waterfall to be the pattern on the decor layer. In contrast, while Pieters may teach to allow a user to utilize a digitized pattern to form a conventional silk screen, there is no teaching nor suggestion to form the pattern on the decor layer from the digitized design. In fact, the paragraph bridging pages 2 and 3 of GB ‘982 states that the pattern is selected, (then, optionally digitally photographed) and, “then either electronically scanned or down-

loaded" into a computer. At no time, is the design selected from a database of already digitized designs. By selecting an already digitized design, the present invention (as recited by claims 30-34) allows the user to skip the step of having to select a wood-grain pattern, "from an original veneer", to be digitized after the selection is made. In any event, Pieters does not produce a decor layer from the digitized design as in the presently claimed process. At best, Pieters teaches one skilled in the art how to make silk screens which are nothing more than a series of holes in a membrane. Furthermore, Pieters does not teach nor suggest to a user to select a digitized design from a database of selectable designs.

The present process permits a digitized design, including nuances of the pattern, e.g., color, intensity, layout, etc., to be reproduced on a decor layer. Simply put, making a silk screen is not the same as making a pattern on a decor layer. See present specification, page 16, second paragraph, and the paragraph bridging pages 16 and 17, as well as the second full paragraph on page 18.

Reconsideration is requested.

III. Conclusion

Applicants respectfully request entry of the above amendments and passage of the application to allowance. If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to telephone the undersigned at the local Washington, D.C. telephone number listed below.

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